

REMARKS

Applicant respectfully requests reconsideration of this application as amended. Claims 1-23 are pending in the application. Claims 1, 4, 10, and 22 have been amended. Claim 23 has been added. No claims have been canceled. No new matter has been added.

Applicant has amended the claims, particularly to overcome the Examiner's rejection of indefiniteness under 35 U.S.C. §112 and to more clearly distinguish the invention from the prior art cited. The Examiner initially rejected claims 1-21 under 35 U.S.C. §112, second paragraph. Accordingly, Applicant has amended claim 1 to particularly point out and distinctly claim, in full, clear, concise and exact terms, the subject matter which Applicant regards as his invention. Claims 2-21 depend from claim 1. The rejections of claims 1-21 have been overcome and withdrawal of the rejections is respectfully submitted.

In the Office Action, Examiner rejected claims 1-21 under 35 U.S.C. 101 as claim 1 is directed to non-statutory subject matter. Applicant respectfully traverses the rejection of claim 1-21.

“To be statutory, a claimed computer-related process must either: (1) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (2) be limited by the language in the claim to a practical application within the technological arts.” (MPEP ¶ 2106).

Applicant respectfully submits that the rejected claims are fully disclosed in the specification and the result in a physical transformation outside the computer for which a practical in the technological arts. Independent claim 1 includes limitations of selecting at least one candidates entity, wherein the selection is more likely for a candidate entity to be distinctive than others with respect to a preexisting art, and creating at least one new candidate entity by creating a variation in the at least one candidate entity.

The independent claim 1 defines distinctive operations to generate a new entity that is distinctive from a preexisting art (e.g., a preexisting technology). The method involves physical manipulation of data structure and architecture of a physical object used to solve the problem. In addition, the independent claim 1 further defines that the selection is more likely for a candidate entity to satisfy a design requirement and to avoid a preexisting art than another entity, which leads to a new, useful, and tangible result. Therefore, the independent claim 1 contains a statutory process, and the statutory requirements are satisfied.

In addition, in reviewing claims, the complete specification should be reviewed, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims and any specific, substantial, and credible utilities that have been asserted for the invention (see, MPEP ¶2106). Applicant submits that the independent claim 1 is fully disclosed throughout the specification.

In the Office Action, the Examiner stated, “applicant’s claims disclose no specific computer medium, no manipulation of specific data representing physical objects or activities; nor do they disclose any specific independent physical acts being performed by the invention.” Applicant respectfully traverses. As discussed above, independent claim 1 discloses distinctive operations to produce new, useful, and tangible results.

“When a computer program is claimed in a process where the computer is executing the computer program’s instruction, the claim should be treated as a process claim, see MPEP ¶2106. The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use can be resolved only on review of the entirety of the record to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” (MPEP ¶2111.02).

As discussed above, independent claim 1 defines distinctive operations to generate a new entity to satisfy a design requirement and to avoid a preexisting art. The process involves physical manipulation of data structure and architecture of a physical object used to solve the problem. The claim is fully disclosed and supported throughout the specification. Thus, Applicant respectfully submits that independent claim 1 satisfies the statutory requirements of 35

U.S.C. §101. The newly added claim 23 is a machine readable medium claim including similar limitations of claim 1. Thus, for reasons similar to those discussed above, claim 22 is patentable. Dependent claims 2-21 depend on the independent claim 1, thus include all the limitations of independent claim 1 and for reasons similar to those discussed above, claims 2-21 are patentable under 35 U.S.C. §101. Withdrawal of the rejection is respectfully submitted.

Claim 22 was rejected under 35 U.S.C. 102(b) as being anticipated by Scepanovic et al. (U.S. Patent No. 5,796,625, hereinafter Scepanovic). It is respectfully traversed. Applicant submits that claim 22 includes limitation of comparing the structure to a preexisting technology and determining fitness of the structure by combining compliance with the technical requirements and dissimilarity of the preexisting technology. These limitations are absent from Scepanovic. Rather, Scepanovic discloses a circuitry layout program that routes a circuitry based on the cost of the circuitry (col. 2, lines 43 to 50), instead of the preexisting technology, particularly, the dissimilarity of the preexisting technology, as claimed in claim 22 of the present application. Therefore, Applicant submits that claim 22 is not anticipated by Scepanovic. Withdrawal of the rejection is respectfully submitted.

CONCLUSION

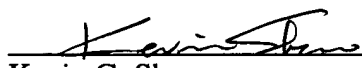
In view of the foregoing, Applicant respectfully submits the present application is now in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Please charge Deposit Account No. 02-2666 for any shortage of fees in connection with this response.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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